

REMARKS

Claims 1-61 are pending and present for examination. The Office Action mailed July 17, 2006 includes a restriction requirement and states that the application contains claims directed to the following patentably distinct species:

Group I: Claims 1-24 and 30-53;

Group II: Claims 25-26, and 54-55¹;

Group III: Claims 27-28 and 56-57;

Group IV: Claims 29, 58, and 61; and

Group V: Claims 59-60.

The Examiner and Applicants' representative conducted telephone interviews on August 10-11, 2006 to discuss the restriction requirement, but agreement was not reached.

Applicants submitted an Amendment on August 17, 2006 and a Notice of Non-Compliant Amendment was mailed on November 15, 2006 stating that the status identifiers of the claims were incorrect. Applicant submitted a revised amendment on December 13, 2006 and a second Notice of Non-Compliant Amendment was mailed on March 6, 2007.

The March 6 Notice stated that Applicants had impermissibly shifted to claiming another invention due to amending claims in Group I to depend from claims in Group II and cited to MPEP 819. In telephone conferences with Examiners Mofiz and Kim on March 16, Applicants' representative explained that MPEP 819 is inapplicable because there has not yet been an action on the elected subject matter. The Examiners tentatively agreed that these claim amendments do not constitute an improper shift.

During the telephone conferences, the Examiners stated that the claim amendments placed the claims in an improper format because some claims depended from higher-numbered base claims. Applicants' representative agreed to revise the claim amendments to address this issue. Accordingly, this amendment cancels dependent claims 4-24 and 33-53, and adds corresponding new claims 62-82 and 83-103. These new claims depend from claims in Group II.

In response to the Office Action, Applicants hereby elect Group II (claims 25-26 and 54-55, plus new claims 62-103), with traverse. The pending claims of the five groups

are not directed to distinct inventions, but rather are different definitions of the same disclosed subject matter, varying in breadth and scope of definition (see MPEP 806.03).

Further, Applicants respectfully submit that the restriction requirement is *prima facie* invalid because it fails to explain why there would be a serious burden on the Examiner if restriction is not required. Under MPEP 808.02, the Examiner “**must** explain why there would be a serious burden on the examiner if restriction is not required.” There are three reasons that can constitute a serious burden: a) separate classification of the claimed inventions; b) separate status in the art when the claimed inventions are classifiable together; and c) different field of search for the claimed inventions. The Office Action fails to identify any of these reasons.

Applicants respectfully submit that search and examination of all the claims in the application can be made without serious burden (see MPEP 803). The claim elements of the different groups identified by the Examiner are sufficiently similar that a search and examination of the claim elements from one group necessarily involve a search and examination of most claim elements of the other groups. For example, amended claims 25 and 26 collectively recite elements comprising:

- receiving a search query (claim 26);
- determining a relevant article associated with the search query (claim 26);
- calculating a predetermined client behavior score based at least in part on client behavior data associated with the article (claim 25); and
- arranging the relevant article based at least in part on the predetermined client behavior score associated with the relevant article (claim 26).

Claim 1, which is in a different group than claims 25 and 26, recites:

- receiving or creating a search query;
- determining a relevant article associated with the search query; and
- determining a ranking score for the relevant article based at least in part on client-side behavior data associated with the relevant article.

Claim 3, which is in the same group as, and depends from, claim 1, further recites:

- arranging the article based upon the ranking score.

Thus, the elements of claim 1 are very similar to those of claims 25 and 26. The elements of claim 27 are likewise similar to those of claims 25 and 26. Claims 28-29 and 59-60

¹ The Office Action listed claim 61 in Groups II and IV. The Notice of Non-Compliant Amendment mailed March 6, 2007 clarified that claim 61 is classified in only Group IV.

recite some elements not found in claims 25-26, but Applicants respectfully submit that searching and examining these additional elements do not constitute a serious burden.

Further, Applicants have amended the claims to correct typographical errors, remove possible ambiguities, and resolve potential antecedent basis issues in order to expedite examination. Specifically, claim 2 has been amended to correct a typographical error. Claims 25 and 54 have been amended to recite “**calculating** a predetermined client behavior score” instead of “determining” the score. In addition, Applicants have amended the “storing” elements of claims 25 and 54 to clarify the association between the predetermined client behavior score and the article. Claims 26 and 55 have been amended to correct possible antecedent basis issues. Claim 61 has been amended to clarify that the client behavior data are from the client behavior data database and correct an antecedent basis issue. Applicants submit that these amendments do not materially alter the scope of the claims or affect the restriction requirement.

For the above reasons, Applicants respectfully request that the Examiner reconsider the restriction requirement and enter the amendment. The Examiner is invited to contact the undersigned by telephone to advance the prosecution of this application.

Respectfully submitted,
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